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09/550,605	04/17/2000	Leif Andersson	064727.0109	1231

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HUNTON & WILLIAMS  
INTELLECTUAL PROPERTY DEPARTMENT  
1900 K STREET, N.W.  
SUITE 1200  
WASHINGTON, DC 20006-1109

EXAMINER

SOUAYA, JEHANNE E

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 06/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

09/550,605

## Applicant(s)

ANDERSSON ET AL.

## Examiner

Jehanne E Souaya

## Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4-15,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,14 and 18 is/are allowed.
- 6) ☒ Claim(s) 7 and 15 is/are rejected.
- 7) ☒ Claim(s) 4-13 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Currently, claims 1, 4-15, and 18-19 are pending in the instant application. All the amendments and arguments have been thoroughly reviewed. Any rejections not reiterated are hereby withdrawn. The following objections and rejections are newly applied. They constitute the complete set being presently applied to the instant Application. This action is NON-FINAL.

#### ***Claim Objections***

2. Claims 4-13 and 19 are objected to for being dependent on a rejected claim. Claim 4 recites dependency to claims 1 or 3, however claim 3 has been canceled. Appropriate correction is required.

#### ***Specification***

3. The amendment filed 8/13/2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The submission of a sequence listing in the response of 8/13/2001 introduces new matter into the disclosure because there is no basis in the specification as originally filed for SEQ ID NOS 2, 10, and 11. SEQ ID NO 2 only contains 24 of the 26 nucleotides set forth as primer KIT 35 on page 8. SEQ ID NO 2, as disclosed in the sequence listing, lacks the last two nucleotides of the sequence; however there is no basis in the specification for a primer lacking these last two nucleotides, consequently the disclosure of SEQ

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ID NO 2 introduces new matter. Secondly, the sequences of SEQ ID NOS 10 and 11 were not present in the specification as originally filed.

Applicant is required to cancel the new matter in the reply to this Office Action. It is noted that a paper copy of the new Sequence Listing as well as a copy in computer readable form will be required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 7 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a New Matter rejection.

The claims as originally filed listed the sequences set forth in claims 7 and 15, however the originally filed claims did not designate a SEQ ID NO. It is noted that while the actual sequence set forth in the claim and designated as SEQ ID NO 2 was present in the originally filed specification, SEQ ID NO 2, which lacks the last two nucleotides -GG- of the second primer, was not. Further, SEQ ID NO 2 in the sequence listing is not the same as the second primer listed in each claim. In addition, the specification as originally filed provided no basis for

a primer lacking the last two nucleotides of the KIT35 primer, therefore, the recitation of SEQ ID NO 2 in the claims adds new matter to the instantly claimed invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 7 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims designate SEQ ID NO 2 as the identifier for the sequence of the second primer, however SEQ ID NO 2 from the sequence listing is not the same as the sequence of the second primer. Consequently the metes and bounds of the claim are unclear because the skilled artisan would not be able to determine whether the sequence of the second primer was the sequence listed, or SEQ ID NO 2.

#### ***Conclusion***

8. Claims 1, 14, and 18 are allowable.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Souaya whose telephone number is (703) 308-6565. The examiner can normally be reached Monday-Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-3014.

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Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Jehanne Souaya*

Jehanne Souaya

Patent examiner

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